

REMARKS

Discussion of the Amendment to the Specification

The specification has been amended to insert Table X, which was inadvertently omitted due to a translator error. This inadvertently omitted portion of the specification is completely contained in PCT/FR03/01030, published as WO 03/084956, and from which the present application claims the benefit. Accordingly, pursuant to 37 C.F.R. § 1.57(a), insertion of the table into the present specification is proper.

Discussion of the Amendment to the Claims

Claims 1 and 2 have been amended to remove recitation of –SO- and –SO₂- as possible values for A, as being drawn to non-elected subject matter.

Claim 1 has been amended also, as discussed in more detail below, to address the Examiner's rejections under 35 U.S.C. § 102.

Claim 1 has been amended also to place the recitation of “a pharmaceutically acceptable salt thereof” in a grammatically proper position.

Claims 13 and 14 have been amended to incorporate “therapeutically effective amount”.

Claims 15 to 30 have been cancelled as being drawn to non-elected subject matter.

These amendments to the specification and claims add no new matter.

As presently amended, claims 1 to 5, and claims 13 and 14 are pending in this application.

Discussion of the Claimed Benefit of Priority Date

The Examiner has denied the claimed benefit of the priority date of French Application No. 02/04,220, filed April 4, 2002 as no certified translation of this priority document was received. Thus, the Examiner assigned a filing date of the instant application as April 2, 2002, which is the filing date of PCT/FR03/0130. (Office Action at 3).

Applicants submit herewith a Certified Translation of the Priority Document, FRANCE 02/04,220. Accordingly, Applicants respectfully request that the priority date for the present application be set as April 2, 2002.

Discussion of the Rejections Under 35 U.S.C. § 112

The Examiner has rejected claims 13 and 14, as previously presented, under 35 U.S.C. §112, second paragraph, as “being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” The Examiner goes on to indicate that, “the claims are self-conflicting. Pharmaceutical compositions by definition must be effective yet non-toxic. Claims 13-14 are pharmaceutical compositions without dosage limitation i.e. included both ineffective and toxic amount.” (Office Action at 3).

Applicants note with appreciation the Examiner’s recommendation that “therapeutically effective amount” be incorporated in the claims. (Office Action at 3).

Claims 13 and 14 have been amended to incorporate the Examiner’s recommendation.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §112 are respectfully requested.

Discussion of the Obviousness Type Double Patenting Rejections

Claims 1 to 5, and claims 13 and 14 stand as provisionally rejected under the judicially created doctrine of obviousness-type double patenting as, the Examiner alleges, being “unpatentable over claims 1-5, 7-10 of U.S. 2006/0199962.” (Office Action at 4). Applicants

note with appreciation the Examiner's indication that "a timely filed terminal disclaimer...may be used to overcome an actual or provisional rejection..." (Office Action at 4).

Because this is a provisional rejection, and because no claims have yet been deemed allowable in this application, Applicants will address this rejection, and the issue of Terminal Disclaimer, when this obviousness-type double patenting rejection is the sole remaining issue.

Discussion of the Rejections Under 35 U.S.C. § 102

Claims 1 and 2 stand provisionally rejected under 35 U.S.C. § 102(a) as, the Examiner alleges, being anticipated by Bora et al., Organic Letters, 2003, Vol.5, pages 435-438 (hereinafter, "Bora et al."). (Office Action at 5).

Bora et al. has a publication date of January 23, 2003 (see, for example, the note at the bottom of page 435). Because the priority date of the present application is April 2, 2002, Bora et al. is improperly cited against that portion of the present application that was disclosed as of the priority date.

Regardless of the date, however, as presently amended no compound disclosed in Bora et al. is encompassed by the claims of the present application. The Examiner points out Table 2 of Bora et al., apparently indicating that compounds 1 to 3 of that table anticipate the claims of the present application as previously presented. However, this is not the case.

Compound 1 of Bora et al.'s Table 2 requires carbomethoxy groups at both the R₁ and R₂ position of Structure 4. These positions correspond to the R₂ and R₁ positions of formula I of the present application, respectively. While Applicants acknowledge that R₁ of formula I can have the value of alkoxycarbonyl, this is not true of Applicants' R₂. With regard to compounds 2 and 3 of Table 2, each of these requires a p-Tolyl group as Bora et al.'s R. This would require a methyl group at the R₄ position of formula I of the instant application. Neither R₃ nor R₄ of the instant application can take on the value of alkyl.

Accordingly, none of the compounds of Table 2 of Bora anticipate the claims as previously presented.

Applicants acknowledge, however, that compound 4a at page 436 of Bora et al. was encompassed by claims 1 and 2 of the present application as previously presented. However, as presently amended, claims 1 and 2 are not anticipated by any compound of Bora et al.

The Examiner has rejected claims 1 and 2 as being anticipated by Kakehi et al., Bulletin of the Chemical Society of Japan, 1996, Vol. 69, pages 1769-1776 (hereinafter, Kakehi et al.). (Office Action at 5,6). The Examiner points to compound 12b, at page 1771 of Kakehi et al.

Compound 12b of Kakehi et al. requires carbomethoxy groups at both the positions which are analogous to the R₁ and R₂ positions of formula I of the present application. As discussed above, R₂ of the claims 1 and 2, as previously presented, does not take on the value of alkoxycarbonyl.

Thus, neither the claims as previously presented, nor the claims as presently amended were or are anticipated by Kakehi et al.

The Examiner has rejected claims 1 and 2 under 35 U.S.C. § 102(b) as, the Examiner alleges, being anticipated by Wei et al., Journal of the Chemical Society, Perkin Transactions 1: Organic and Bio-organic chemistry, 1993, Vol. 20, pages 2487-9 (hereinafter, "Wei et al."). (Office Action at 6).

At page 6 of the Office Action the Examiner points out the following compounds disclosed in Wei.

RN 25627-81-0, 3-benzoyl-1-indolizinecarbonitrile. This compound requires a cyano group at the position analogous to R₁ of the present application. R₁ of formula I of the present application, as previously presented in claims 1 and 2, did not take on the value of cyano.

RN 25627-86-5, 3-benzoyl-1-indolizinecarboxamide. This compound requires a CONH_2 group at the position analogous to R_1 of the present application. R_1 of formula I of the present application, as previously presented in claims 1 and 2, did not take on the value of CONH_2 .

RN 154224-58-5, 3-benzoyl-1,2-indolizinedicarboxylic acid, diethyl ester. This compound requires carboethoxy groups at both positions analogous to R_1 and R_2 of the present application. R_2 of the present application, as previously presented in claims 1 and 2, did not take on the value of alkoxycarbonyl.

Thus, none of these three compounds anticipated claims 1 and 2 as previously presented.

Applicants acknowledge that the compound RN 17281-79-7, 3-benzoyl-1-indolizinecarboxylic acid, methyl ester (pointed out at page 6 of the Office Action), and the compound RN 154224-59-6, 3-benzoyl-2-methyl-1-indolizinecarboxylic acid, methyl ester (pointed out at page 7 of the Office Action) were encompassed by claims 1 and 2 as previously presented.

However, as presently amended, claims 1 and 2 are not anticipated by any compound disclosed by Wei et al.

The Examiner has rejected claims 1 and 2 under 35 U.S.C. § 102 (b) as being anticipated by Tamura et al., Journal of the Chemical Society, Perkin Transactions 1: Organic and Bio-Organic Chemistry, 1973, Vol. 19, pages 2091-5 (hereinafter, "Tamura et al."). (Office Action at 7). The Examiner points out compound (VI) at page 2092 of Tamura et al.

Applicants acknowledge the compound VI of Tamura et al. was encompassed by claims 1 and 2 of the present application, as previously presented.

However, as presently amended, claims 1 and 2 are not anticipated by compound VI of Tamura.

The Examiner has rejected claims 1 and 2 under 35 U.S.C. § 102(b), as being anticipated by Overzet et al., Journal of Pharmaceutical and Biomedical Analysis, 1984, Vol. 2, pages 3-17 (hereinafter, "Overzet et al."), and points to compound RN 94419-24-6, [4-[3-(dibutylamino)propoxy]phenyl(2-ethyl-1-hydroxy-3-indoliziny)]methanone of Overzet et al. (Office Action at 7).

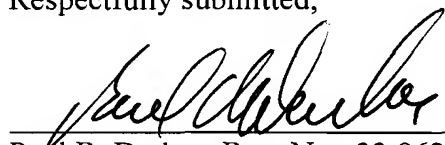
Applicants acknowledge that this 1-hydroxy compound was encompassed by claims 1 and 2 of the present application, as previously presented. However, claims 1 and 2, and presently amended, are not anticipated by any compound of Overzet et al.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are respectfully requested.

In view of the above amendment and remarks, Applicants submit that the claims of the present application are novel and non-obvious over the prior art, and comply with the requirements of 35 U.S.C. § 112. Accordingly, allowance and passage to issue of claims 1 to 5, and 13 and 14 are respectfully requested.

Respectfully submitted,

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